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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,244	12/07/2004	Hiroyuki Morioka	112857-402	3110
29175	7590	01/02/2009	EXAMINER	
BELL, BOYD & LLOYD, LLP			WARTALOWICZ, PAUL A	
P. O. BOX 1135				
CHICAGO, IL 60690			ART UNIT	PAPER NUMBER
			1793	
			MAIL DATE	DELIVERY MODE
			01/02/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/517,244	MORIOKA ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	PAUL A. WARTALOWICZ	1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 23 September 2008.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 27,28,35,36 and 39-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 27,28,35,36 and 39-42 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/10/08</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|   | 6) <input type="checkbox"/> Other: _____ .                        |

***Response to Arguments***

Applicant's arguments filed 9/23/08 have been fully considered but they are not persuasive.

Applicant argues that Percharsky fails to teach a hydride excluding alkali metals.

However Percharsky discloses a hydride that does not have alkali metals at col. 4, lines 11-18 when x=0 comprising a solid hydride of formula AlH<sub>3</sub>. See col. 4, lines 11-28, line 24 in particular.

Applicant argues that all of Percharsky's examples are drawn to a hydride doped with alkali metals.

However, "the prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed...." See In re Fulton, 391 F.3d 1195, 1201, 73 USPQ2d and MPEP 2141.02.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 27-28, 35, 36, and 39-42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to

reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

It appears that line 15 of claims 27 and 28 is new matter. The absence of a component or step does not nor cannot support the exclusion of said component or step in a claim. However, “consisting of” language would exclude said component or step.

### ***Claim Rejections - 35 USC § 102/103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 27-28, 35, 36, and 39-42 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Pecharsky et al. (6773692).

Pecharsky disclose the instantly claimed hydrogen occluding material and the method of using the hydrogen occluding material. Pecharsky teaches a solid hydride of formula AlH<sub>3</sub> (Column 4, lines 11-28, line 24 in particular) and that the hydride releases hydrogen at temperature in the range from -200°C to about 100°C (Column 4, line 65 through Column 5, line 5) in an inert atmosphere (col. 5). Pecharsky also teaches the use of a catalyst in combination with the hydride, the catalyst selected from metals belonging to periods III to V of the periodic table (Column 4, lines 42-52), that the catalyst and hydride are powders (Column 5, line 6), and also that the catalyst is present in an amount of about 0.1-25 mol%, about 1-15 mol%, or even about 3-5 mol% (Column 4, lines 53-64).

Additionally, it appears that Percharsky discloses a hydride that does not have alkali metals (col. 4, lines 11-18, x=0) comprising a solid hydride of formula AlH<sub>3</sub> (Column 4, lines 11-28, line 24 in particular).

As to the claim limitations wherein the hydrogen release occurs in one step, the materials of Pecharsky appear to be the same as those that are claimed and therefore would inherently exhibit the same hydrogen capacity.

Pecharsky disclose the instantly claimed hydrogen occluding material and the method of using the hydrogen occluding material as described with respect to claims 27 and 28 above.

If the teachings of Pecharsky as described above do not anticipate the instantly claimed limitations, they would be obvious because Pecharsky specifically teaches that the catalyst to be included in the material is a transition metal, and specifically comprises “a transition metal of the 3<sup>rd</sup> (Sc through Zn), the 4<sup>th</sup> (Y through Cd), or the 5<sup>th</sup> (Hf through Hg) period of the periodic table, or lanthanide elements (La through Lu), or their derivatives, or mixtures thereof” and that titanium is preferred in Column 4, lines 42-52. This teaching includes not only groups III-V of the periodic table but also includes Cr, Fe, and Ni; thus Pecharsky teach that mixtures of this may be used.

Additionally, one of ordinary skill in the art at the time applicant's invention was made would have recognized to use Ti as a dopant through routine experimentation.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL A. WARTALOWICZ whose telephone number is (571)272-5957. The examiner can normally be reached on 8:30-6 M-Th and 8:30-5 on Alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman can be reached on (571) 272-1358. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Paul Wartalowicz  
December 28, 2008

/Steven Bos/  
Primary Examiner  
A.U. 1793